6The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte PAUL M. SCOPTON

Appeal No. 2005-2219
Application No. 09/498,104

ON BRIEF

Before FRANKFORT, CRAWFORD, and BAHR, Administrative Patent Judges.
CRAWFORD, Administrative Patent Judge.

REMAND TO THE EXAMINER

The above-identified application is hereby remanded to the examiner for appropriate action consistent with our comments below.

The examiner has made three rejections of the claims in this case: (1) claims 1 to 5 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Sirhan; (2) claims 1 to 5 and 7 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Crittenden and (3) claims 1 to 5 and 7 to 9 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Horzewski.

The examiner is reminded that in order to establish a prima facie case of anticipation of a claim, the examiner must establish that each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987).

In regard to the rejection of claims 1 to 5 and 7 as anticipated by Crittenden, the examiner does not establish that each element of claim 1 is described by Crittenden. Rather, the examiner makes a conclusory statement that Crittenden describes the elements of claim 1 by copying claim 1 without reference to the subject matter described in Crittendon. The only reference to the Crittenden disclosure is made at the end of the statement by merely referencing, without explanation, Figures 1, 7, 9, 11, 12 and the entire reference. Missing from the final rejection and answer is an explanation, of what elements described in Crittenden are considered to meet the elements of the claims.

For instance, the examiner has not stated what is considered a proximate guidewire port. Having no guidance from the examiner about what element in the Crittenden disclosure is considered by the examiner to be a proximate guidewire port, the appellant in the brief assumes that the examiner considers the longitudinal slits to be the guidewire ports. In the answer, the examiner, for the first time, explains that the proximal guidewire port occurs at number 50 and is not considered to be the longitudinal slits. The appellant

in the reply brief argues that number 50 is not a proximal guidewire port but is rather the end of tube 48.

The examiner did not file a supplemental answer responding to the assertion by the appellant that element 50 is the end of tube 48 and can not be considered a proximal guidewire port. Instead, in a paper mailed April 21, 2005 the examiner merely indicated that the reply brief was reviewed and entereed.

Our examination of Crittenden reveals that element 50 is indeed the end of tube 48. If tube 48 is considered the guidewire extension, element 50 is the end of the guidewire extension not the proximal guidewire port. However, we are not informed by the answer what the examiner means by the proximal guidewire port "occurs" at 50. In our view, it is possible that the examiner considers the area where the tube 48 enters the passageway 44 to be the proximal guidewire port but this is not clear from the answer.

Therefore, this case is remanded to the examiner for the examiner to clearly explain how the elements of the claims rejected are described by Crittenden. This explanation should include references to the Crittenden reference by column and line and the figures including reference numbers.

In regard to the other two anticipation references, the examiner is to respond to the arguments in the reply brief which have been made in response to the explanation of the anticipation rejections, for the first time, in the examiner's answer.

This application, by virtue of its "special" status, requires an immediate action, *MPEP* § 708.01(D). It is important that the Board be promptly informed of any action affecting the appeal in this application.

REMANDED

CHARLES E. FRANKFORT
Administrative Patent Judge

MURRIEL E. CRAWFORD
Administrative Patent Judge

JENNIFER D. BAHR
Administrative Patent Judge

) BOARD OF PATENT
) APPEALS
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